

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Eric THELEN, et al.

Atty. Docket
DE 030365US1

Confirmation No. 1808

Serial No. 10/576,165

Group Art Unit: 2425

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Examiner: CHOKSHI, Pinkal R.

Title: RECORDING CONTENT ON A RECORD MEDIUM THAT CONTAINS A
DESIRED CONTENT DESCRIPTOR

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Board of Patent Appeals and Interferences
United States Patent and Trademark Office
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APPELLANTS' REPLY BRIEF

Sir:

In response to the Examiner's Answers mailed on October 27, 2010, please
consider the following remarks:

REMARKS

Appellants maintain the arguments submitted in the Appeal Brief filed on September 7, 2010, which is incorporated herein by reference. Further, Appellants refute the allegations made in the Examiner's Answer of October 27, 2010.

In particular, in the Response to Argument section beginning on page 14 of the Examiner's Answer of October 27, 2010, it is alleged that the present invention, as recited in independent claim 1, is obvious over U.S. Patent No. 5,526,130 (Kim) in view of U.S. Patent Application Publication No. 2005/0120373 (Thomas) and U.S. Patent No. 6,925,650 (Arsenault), where paragraphs [0061], [0067], [0177]-[0179] and [0188] of Thomas are relied on for allegedly disclosing "wherein inserting the record medium containing the desired content descriptor into the second device triggers the second device to automatically perform the acts of scanning and recording," as recited in independent claim 1.

This allegation is respectfully traversed. It is respectfully submitted that paragraphs [0061] and [0067] of Thomas describe a set-top box 60 that include a storage device such as a hard disk. The set-top box 60 may have access to additional storage provided by a removable medium 62, or the set-top box 60 may be connected to a removable media access device, into which the removable medium 62 may be inserted. Such a disclosure has nothing to do with and does not disclose or suggest "wherein inserting the record medium containing the desired content descriptor into the second device triggers the

second device to automatically perform the acts of scanning and recording," as recited in independent claim 1.

Further, [0177]-[0179] and [0188] of Thomas recite that the removable medium 62 includes a configuration file having a reference to selected content, where an "interactive television application may establish communications with removable medium 62 when removable medium 62 is inserted into set-top box 60." (Thomas; paragraph [0179], lines 3-5; emphasis added)

Again, such a disclosure has nothing to do with and does not disclose or suggest "wherein inserting the record medium containing the desired content descriptor into the second device triggers the second device to automatically perform the acts of scanning and recording," as recited in independent claim 1.

Further, while Thomas does disclose that the removable medium 62 includes the configuration file having the reference to selected content, Thomas specifically recites in paragraph [0177] that it is "the interactive television application [that] may create and transfer the configuration file to the removable medium," where the configuration file includes a reference to selected content. (Thomas; paragraph [0179], lines 5-7; emphasis added)

The very same interactive television application that creates and transfers the configuration file having the reference to selected content to the removable medium, also transfers "the referenced digital content to removable medium 62." (Thomas; paragraph

[0188], lines 2-3; emphasis added)

That is, in Thomas, the very same interactive television application stores both the reference to the selected digital content and the referenced digital content to removable medium 62. Thomas does not disclose or suggest one device that stores a descriptor on a record medium, while a different device reads the descriptor and stores content matching the descriptor on the record medium.

Regarding Arsenault, as recited on column 18, lines 15-18, keywords are stored in a memory 148 of a receiver 132 by the receiver manufacturer. As clearly shown in FIG 4, the memory 148 that stores a keyword list is an internal/integrated memory of the receiver 132 and is NOT an insertable record medium.

In the paragraph spanning pages 15-15 of the Examiner's Answer, it is alleged that "Kim reads the descriptor, scans and records the desired content, Thomas teaches the content descriptor comes from the insertable removable medium, and Arsenault teaches the descriptor stored in the device can actually come from the service provider." This allegation is respectfully traversed in part. (Emphasis added)

While Thomas teaches that the content descriptor and content are stored on an insertable removable medium, Thomas specifically teaches that it is the very same interactive television application that stores both the descriptor and the content on an insertable removable medium. Further, Arsenault teaches the descriptor is stored by a device manufacturer in a device, namely, the receiver 132. Storing descriptors on an

insertable record medium is nowhere disclosed or suggested in Arsenault.

It is respectfully submitted that one skilled in the art would not arrive to the present invention from the combination of Kim, Thomas and Arsenault. Such a combination, at best, discloses or suggests that a device manufacturer records keywords in a device as thought by Arsenault, and NOT in any insertable record medium, where recording on a record medium of both the content and descriptor is done **by the very same interactive television application** of Thomas.

It is respectfully submitted that Kim, Thomas, Arsenault, and combinations thereof, do not disclose or suggest the present invention as recited in independent claim 1 which, amongst other patentable elements, recites (illustrative emphasis provided):

storing said desired content descriptor on said record medium **by a first** device;

reading said desired content descriptor from said record medium **by a second** device local to a user of the record medium, wherein the first device is remote from the local device, and wherein the first device is associated with a provider of the record medium and is different from the second device;

scanning by the second device the content of at least one multimedia source for desired content that matches said desired content descriptor; and

recording by the second device said desired content on said record medium, wherein inserting the record medium containing the desired content descriptor into the second device triggers the second device to automatically perform the acts of scanning and recording.

Storing a descriptor on a record medium by one device, and automatically scanning and recoding (on the record medium) content that match the descriptor by a second device

upon inserting the second medium containing the desired content descriptor into the second device, is nowhere disclosed or suggested in Kim, Thomas and Arsenault, alone or in combination.

Based on the foregoing, it is respectfully requested that the rejection under 35 U.S.C. §103(a) of independent claim 1 be reversed, and independent claim 1 be allowed. In addition, it is respectfully submitted that claims 4-18 and 23-24 should also be allowed at least based on their dependence from independent claim 1.


In addition, Appellants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Appellants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

CONCLUSION

Claims 1, 4-18 and 23-24 are patentable over Kim, Thomas and Arsenault.

Thus, the Examiner's rejections of claims 1, 4-18 and 23-24 under 35 U.S.C. §103(a) over Kim, Thomas and Arsenault should be reversed.

Respectfully submitted,

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